

## REMARKS

Claims 1, 4 through 11 and 14 through 20 are pending in this Application. Claims 1, 4, 6, 7, 10, 11, 14 and 15 have been amended, claim 3 cancelled and new claims 17 through 20 added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicant submits that the present Amendment does not generate any new matter issue.

### Claim Objection

The Examiner objected to claim 15 noting an apparent typographical error and courteously suggesting remedial language. By the present Amendment claim 15 has been amended consistent with the Examiner's suggestion, thereby overcoming the stated basis for the claim objection. Accordingly, withdrawal of the objection to claim 15 is solicited.

**Claims 1, 3, 6 through 11 and 14 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Chiu et al.**

In the statement of rejection the Examiner **acknowledged various differences** between the invention as defined in the rejected claims and Chiu et al., but then arrived at the obviousness conclusion **without** presenting any additional **factual** basis. This rejection is traversed.

Initially, the Examiner's rejection runs afoul of consistent legal precedent by failing to provide a factual basis to support the asserted motivation to span the **admitted differences** between the claimed optical module and that disclosed by Chiu et al. In this respect the Examiner's attention is invited to *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374, wherein the Court held that regardless of the source of motivation, factual

basis must still be provided. On this basis alone the imposed rejection under 35 U.S.C. § 103 cannot stand.

Specifically, in the paragraph bridging pages 2 and 3 of the September 28, 2005 Office Action, after admitting that Chiu et al. do not disclose a block mounted on lower casing, the Examiner asserts:

Since Applicant has not disclosed that mounting the block on the lower casing solves any stated problem or is for any particular purpose, and it appears the invention would perform equally well with a block mounted to the lower casing, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have mounted a block to the lower casing in any fashion as long as the block is securely fastened and defines a relative position for the optical components.

This approach is **legally erroneous** for at least two reasons. First, as previously pointed out, no factual basis has been provided to support the asserted motivation. *Teleflex Inc. v. Ficosa North America Corp., supra*. Further, the Examiner's approach places the cart before the horse, because the Examiner bears the **initial burden** of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision, including 35 U.S.C. § 103. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997). Until such time that a *prima facie* case has been established there is **no** burden upon an Applicant to come forward with any argument or any evidence, or to identify any problem that was solved. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

At any rate, independent claim 1 has been clarified by reciting that the block, which is mounted on the lower casing, has a substrate supporting portion, a substrate pressing portion and a mounting portion. Independent claim 1 further specifies that the substrate is supported by the block. Independent claims 1 further specifies that the block supports the optical subassembly in the mounting portion and the substrate by sandwiching between the substrate supporting portion

and the substrate pressing portion to define relative positions of the block, the optical sub-assembly and the substrate. No such structure is disclosed or suggested by Chiu et al.

As previously argued in the Amendment submitted July 11, 2005, according to the optical module disclosed by Chiu et al., the circuit board 250 is held by the signal leads 201 provided with the receiver 111. Therefore, relative positions of the receiver 111 (which may be considered to correspond to the optical sub-assembly of the present invention) and the circuit board 250 are unstable, as shown in Fig. 2 of Chiu et al. Accordingly, stress is generated at the connection portion between the leads 201 and the circuit boards 250. Clearly, Chiu et al. neither disclose nor suggest an optical module comprising a block which supports the optical sub-assembly in the mounting portion and the substrate by sandwiching between the substrate supporting portion and the substrate pressing portion to define **relative positions** of the block, the optical subassembly and the substrate.

Applicant further separately argue the patentability of the dependent claims, notably **claim 14** and claims dependent thereon. Claim 14, dependent upon claim 1, further specifies that the optical sub-assembly is **inserted** into an opening in the surface of the receptacle and the opening of the block. No such structure is disclosed or suggested by Chiu et al.

Applicant, therefore, submits that the imposed rejection of claims 1, 3, 6 through 11 and 14 under 35 U.S.C. § 103 for obviousness predicated upon Chiu et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Applicant acknowledges, with appreciation, the Examiner's allowance of claims 15 and 16, and the Examiner's indication that claims 4 and 5 contain allowable subject matter.

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Applicant submits that claims 4 and 15, although presently amended, remain free of the applied prior art.

**New claims 17 through 20.**

New claims 17 through 20 are clearly free of the applied prior art for reasons which should be apparent from the arguments previously advanced. Specifically, claim 17 depends from claim 1 through claim 14, and hence, is free of the applied prior art for reasons previously argued with respect to claims 1 and 14. Claim 18 is directed to an optical module wherein the optical subassembly is mounted on the block which supports the substrate by sandwiching between a substrate supporting portion and a substrate pressing portion. Claim 19 depends from claim 18. Claim 20 is directed to an optical module comprising, *inter alia*, an optical subassembly inserted into the opening of a front wall of a block and into the opening of a receptacle. No such optical modules are disclosed or suggested by Chiu et al.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

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Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'A. J. Steiner', written over the printed name.

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